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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/929,960

08/15/2001

L. Michael Maritzen

80398.P425

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03/15/2005

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EXAMINER

POPHAM, JEFFREY D

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,960

Applicant(s)

MARITZEN, MICHAEL L. ET AL.

Examiner

Jeffrey D. Popham

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20020123, 20021101</u> . | 6) <input type="checkbox"/> Other: <u>See Continuation Sheet.</u> |

Continuation of Attachment(s) 6). Other: 20030703, 20031014, 20040315, 20040518, 20040704, 20040805, 20041014, 20041216.

Remarks

Claims 1-24 are pending.

Claim Objections

1. Claims 1, 6, 12-14, and 16 are objected to under 37 CFR 1.75(a) because of the following informalities:

- Claim 1, line 5 recites the limitation "the registration". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, "the registration" has been construed as "registration".
- Claim 6, line 3 recites the limitation "the assets" and "said account". There is insufficient antecedent basis for these limitations in the claims. For purposes of prior art rejection, "the assets" has been construed as "assets" and it has been assumed that this claim is dependent upon claim 4, as this gives "said account" proper antecedent basis.
- Claim 12, line 2 recites the limitation "the supplier". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, it has been assumed that this claim is dependent upon claim 11, as this gives "the supplier" proper antecedent basis.
- Claim 13, line 2 recites the limitation "the account". There is insufficient antecedent basis for this limitation in the claims. For

Art Unit: 2137

purposes of prior art rejection, it has been assumed that this claim is dependent upon claim 11, as this gives "the account" proper antecedent basis.

- Claim 14, line 13 recites the limitation "the account". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, "the account" has been construed as "an account".
- Claim 16, line 2 recites the limitation "the supplier". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, "the supplier" has been construed as "a supplier".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Piosenka et al. (U.S. Patent 4,993,068).

Regarding Claim 7,

Art Unit: 2137

An article comprising:

A storage medium at a trusted entity (Column 6, lines 49-54) including instructions stored thereon which when executed cause a digital system to perform a method including:

Registering a first biometric data of a user with the trusted entity (Column 4, lines 55-60);

Sensing a second biometric data from a person (Column 8, lines 33-35);

Comparing the second biometric data to the first biometric data (Column 8, lines 48-57); and

Preventing the person from registering the second biometric data at the trusted entity associated with the user if the biometric data does not match the first biometric data (Column 11, lines 32-35).

Regarding Claim 1,

Claim 1 is a method claim that corresponds to system claim 7 and is rejected for the same reasons.

Regarding Claim 8,

Storing a copy of the first biometric data on a transaction device (Column 6, lines 31-38).

Regarding Claim 2,

Claim 2 is a method claim that corresponds to system claim 7 and is rejected for the same reasons.

Art Unit: 2137

Regarding Claim 9,

Storing a copy of the first biometric data on one of a privacy card, a digital wallet, and a privacy card configured to be coupled to a digital wallet (Column 6, lines 39-47).

Regarding Claim 10,

Notifying in real-time one of a security entity and the user of an unauthorized attempt to register the second biometric data (Column 12, lines 7-15).

Regarding Claim 3,

Claim 3 is a method claim that corresponds to system claim 10 and is rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al. in view of Waterbury (U.S. Patent 3,896,266).

Regarding Claim 11,

Piosenka et al. disclose accessing a financial account of the person provided that the first biometric data matches the second

biometric data (Column 10, lines 28-40), but do not disclose transferring funds in real-time.

Waterbury, however, discloses transferring funds in real-time to a supplier (Column 9, line 61 to Column 10, line 3). It would have been obvious to incorporate the biometric identification system of Waterbury into the biometric identification system of Piosenka et al. in order to identify that the person attempting to obtain credit is the actual credit card holder with full confidence.

Regarding Claim 4,

Claim 4 is a method claim that corresponds to system claim 11 and is rejected for the same reasons.

Regarding Claim 12,

Piosenka et al. disclose withholding an identification of the person from the supplier (Column 9, line 65 to Column 10, line 3).

Regarding Claim 5,

Piosenka et al. disclose the step of withholding identifying information associated with the first biometric data from the supplier (Column 9, line 65 to Column 10, line 3).

Regarding Claim 13,

Piosenka et al. do not disclose the earmarking of transfer of assets.

Waterbury, however, discloses performing one of earmarking assets of the user and transferring assets of the

Art Unit: 2137

account in real-time to pay for one of a product and a service (Column 9, line 61 to Column 10, line 3). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the biometric identification system of Waterbury into the biometric identification system of Piosenka et al. in order to identify that the person attempting to obtain credit is the actual credit card holder with full confidence.

Regarding Claim 6,

Claim 6 is a method claim that corresponds to article claim 13 and is rejected for the same reasons.

Regarding Claim 14,

Piosenka et al. disclose a method of performing an electronic transaction using a transaction device comprising:

Registering a first biometric data with a trusted entity in which the first biometric data is associated with a user (Column 4, lines 55-60);

Storing a copy of the first biometric data on the transaction device (Column 6, lines 31-38);

Providing the transaction device to the user (Column 6, lines 31-38);

Sensing a second biometric data from a person (Column 8, lines 33-35);

Art Unit: 2137

Comparing the second biometric data to the first biometric data stored on the transaction device (Column 8, lines 48-57);

Authenticating the transaction provided that the second biometric data matches the first biometric data (Column 11, lines 36-41);

Authorizing the electronic transaction (Column 11, lines 35-41).

Piosenka et al. do not disclose earmarking or transferring of assets.

Waterbury, however, discloses performing one of earmarking assets of the user and transferring assets of an account in real-time to pay for one of a product and a service (Column 9, line 61 to Column 10, line 3). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the biometric identification system of Waterbury into the biometric identification system of Piosenka et al. in order to identify that the person attempting to obtain credit is the actual credit card holder with full confidence.

Regarding Claim 15,

Piosenka et al. disclose the step of notifying in real-time one of a security entity and the user of an unauthorized attempt to access financial credit of the user (Column 12, lines 7-15).

Regarding Claim 16,

Piosenka et al. disclose the step of withholding an identification of the user from a supplier (Column 9, line 65 to Column 10, line 3).

3. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al. in view of Lane (U.S. Patent 5,623,552).

Regarding Claim 17,

Piosenka et al. disclose a system for preventing a person from improperly obtaining financial credit comprising:

A recording medium of a trusted entity configured to register a first biometric data of a user (Column 4, lines 55-60);

A processor, coupled to the recording medium (Column 4, lines 17-29), configured to store the first biometric data onto a transaction device (Column 6, lines 31-38) and to prevent registration of a second biometric data that fails to match the first biometric data (Column 11, lines 32-35);

The transaction device comprising a chip configured to store the first biometric data (Column 6, lines 39-47); and

Means for preventing the person from improperly receiving financial credit if the person's second biometric data fails to match the first biometric data (Column 10, lines 28-40 and Column 11, lines 32-35).

Piosenka et al. do not disclose that there is a sensor on the transaction device.

Lane, however, discloses that the transaction device comprises a sensor to sense the second biometric data from a person (Column 5, lines 6-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the ID card of Lane into the biometric detection system of Piosenka et al. in order to obtain a card that can authenticate the user by itself with a high degree of accuracy and security (Column 10, lines 1-3).

Regarding Claim 18,

Piosenka et al. disclose that the transaction device is selected from the group consisting of a privacy card, a digital wallet, and a privacy card configured to be coupled to a digital wallet (Column 6, lines 39-47).

Regarding Claim 19,

Piosenka et al. disclose that a party is electronically notified of an unauthorized use of the transaction device (Column 12, lines 7-15).

Regarding Claim 20,

Piosenka et al. disclose that the party is one of an owner of the transaction device and a security authority (Column 12, lines 7-15).

4. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane (U.S. Patent 5,623,552) in view of Infosino (U.S. Patent 6,715,679).

Regarding Claim 21,

Lane discloses an electronic transaction device for use in a consumer purchasing system comprising:

Security logic, disposed on a processor of the transaction device, configured to compare a registered first biometric data of an authorized user to a second biometric data read from a person attempting to use the transaction device (Column 5, lines 37-47).

Lane does not disclose a transaction device identifier.

Infosino, however, discloses that the transaction device has a transaction device identifier providing no apparent identification of a user authorized to use the transaction device (Column 4, lines 24-27, wherein the universal card is only imprinted with the universal account number and none of the other optional data); and

Communication logic, disposed on a processor of the transaction device, configured to communicate the transaction device identifier to the system to perform a transaction, the system comprising a secure mechanism for correlating the device identifier and the user (Column 10, lines 51-59).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the universal card

Art Unit: 2137

of Infosino into the ID card of Lane in order to provide the functionality that a single universal card can be transformed to act as completely separate cards (from credit cards to movie rental cards) (Column 10, line 66 to Column 11, line 10 and Column 8, lines 29-37).

Regarding Claim 22,

Lane discloses that the transaction device is selected from a group consisting of a privacy card, a digital wallet, and a privacy card configured to be coupled to a digital wallet (Column 5, lines 6-20).

Regarding Claim 23,

Lane discloses that the security logic that confirms an identification of an authorized user is selected from the group consisting of a PIN code and a fingerprint (Column 5, lines 37-47).

Regarding Claim 24,

Lane discloses that the communication logic is selected from the group consisting of a smart card chip interface, contactless connection, magnetic stripe, and wireless communication (Column 5, line 62 to Column 6, line 12).

Art Unit: 2137

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**